

### **REMARKS**

In this reply, claims 22-46 are pending in this application. No new matter has been added. The remarks included in the reply filed October 20, 2010, in this matter are hereby incorporated by reference into this paper.

#### **Changes to the Claims:**

Claims 22, 37, 39, 44, and 45 have been amended to more clearly define the bounds of the present invention. No new matter has been added.

#### **Rejection Under 35 U.S.C. § 103:**

Claims 22-23, 28-29, 31, 33, 35-36, and 43-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwama (U.S. Patent No. 6,600,735, hereafter Iwama) in view of Poretsky (U.S. Patent No. 6,141, 322, hereafter Poretsky).

Claim 43 recites the features “determining whether resources in the second PSTN are available to take the call initiated in the first PSTN; issuing a resource-availability confirmation message from the second PSTN if resources are available therein to take the call; and conducting call setup signaling within the data network only after receiving the resource-availability confirmation message from the second PSTN.” Claim 22 recites similar features. The proffered combination of prior art does not render these features obvious.

On page 3, the OA acknowledges that Iwama does not disclose the above features, and supplies Poretsky to cure this deficiency. The OA cites the connection admission control (CAC) feature of the ATM switch of Poretsky as equivalent to the feature of implementing call setup through the data network once information indicates that resources are available in the second telephony network. Applicant submits that the referenced feature of Poretsky is not equivalent to Applicant’s above-quoted features, and further contends that the combination of references does not suggest Applicant’s claim features.

The Supreme Court has stated that “a patent composed of several elements is not proved obvious *merely* by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Intern. Co. v. Teleflex Inc.* 127 S.Ct. 1727, 1741 (emphasis added). The Court adds that it is important to “important to identify a reason that would have prompted a person of ordinary skill in

the relevant field to combine the elements in the way the claimed new invention does.” *Id.* In this case, the combination of prior art does not show *either* that (a) each of the elements was known in the prior art *or* (b) what reason would have prompted one to modify the prior art to meet the features of Applicant’s claims. These issues are dealt with in turn below.

Poretsky discloses that the availability of bandwidth of a device is evaluated before sending data through that device. However, nothing in Poretsky discloses the feature, of claim 43, of “conducting call setup signaling within the data network only after receiving the resource-availability confirmation message from the second PSTN”. It is noted that the OA concedes, on page 3 thereof, that Iwama does not disclose this feature. Accordingly, even when combined as proposed in the OA, the combination of Iwama and Poretsky does not disclose all of the features of claim 43, or suggest checking the bandwidth of a more distant network before expending effort to set up a call in a more proximate network.

#### **Response to New Arguments in Present Action:**

In the “Response to Arguments” section, the OA, while apparently conceding that the prior art, including Poretsky, does not disclose the claim 43 feature of checking resources on a second PSTN before setting up a call in a data network, nevertheless asserts that the teachings of Poretsky are “analogous” to this feature. The Applicant respectfully contends that “analogousness” is not the test for obviousness under 35 U.S.C. § 103. The Applicant has searched the case law, and can find no evidence of the existence of an “analogy” of two methods rendering one method (or apparatus) obvious in light of the other.

However, the Applicant responds to the “analogy” allegation in the OA below, notwithstanding the above-stated refutation of its relevance to an analysis under 35 U.S.C. § 103. Applicant respectfully contends that the teachings of Poretsky are not analogous to the features of Applicant’s claims that the OA concedes are missing from Iwama. Applicant respectfully contends, as a starting point, that the pertinent test for analogousness is a comparison of the teachings of the prior art to the inventive features of Applicant’s claims, not to the well known features common to both the Applicant’s disclosure and the specifications of the prior art references. At the closest from the Examiner’s viewpoint, Poretsky merely teaches to check for the availability of bandwidth in a communication network element (a switch in the case of Poretsky) prior to sending data through that network element. However, the feature in Applicant’s claims that is missing from Iwama is the process of checking a distant network for bandwidth availability, to avoid needlessly expending the

expense and effort of setting up a call in a more proximate network, in the event that bandwidth is not available in the more distant network. Neither Iwama nor Poretsky discloses this feature, and Applicant therefore respectfully contends that the combination of these two references contains nothing analogous to the inventive features of Applicant's claims.

**There is No Motivation to Combine the Reference Teachings:**

As stated above, the law of obviousness requires that there be a "reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Intern. Co.* at 1741. Applicants contend that no such reason, (or otherwise stated, "motivation") to combine the reference teachings is present in this matter.

We have shown above that Poretsky teaches no more than to test the bandwidth availability of a switch before transmitting data through the switch. Iwama is directed to enabling the provision of telephone communications over a data network in spite of the fluctuating nature of Internet data traffic. Iwama discloses that in the event that a called-side gateway device has a connectability problem, the gate keeper marks that gateway device as being "out of service." See col. 4, lines 32-36. The teachings of Poretsky are similar to the above, in that data traffic to a network device (a switch in the case of Poretsky) is prevented if that device is not available for data traffic at that point in time. Accordingly, the teachings of Poretsky would add nothing to the teachings already present in Iwama that would help the system of Iwama. There is thus no reason to introduce the teachings of Poretsky to the system of Iwama.

Because there is no motivation to combine Poretsky with Iwama, and because the teachings of the two references, even when combined, do not render the present claims obvious, Applicant's claims are not obvious in light of the teachings of Iwama and Poretsky. Based on the foregoing, claims 22 and 43 are not obvious over Iwama in view of Poretsky under 35 U.S.C. § 103. The dependent claims are patentable by virtue of their dependency on independent claims 22 and 43.

**Rejection Under 35 U.S.C. § 103:**

Claims 24-27, 30, 32, 34, and 37-42 and 45-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Iwama, in view of Poretsky, further in view of Elliott et al. (U.S. Patent No. 6,614,781, hereafter Elliott). Applicant has already shown that claims 22 and 43 recite features not disclosed by, or rendered obvious by, the combination of Iwama or Poretsky. Moreover, Elliott does

not cure these deficiencies. Accordingly, claims 22 and 43 are patentable over the combination of Iwama, Poretsky, and Elliott. Independent claims 37 and 39 recite features closely related to those in claims 22 and 43, while also reciting the feature of SS7 signaling. In the rejection under this section, the Elliott reference is used to supply the feature of SS7 signaling, but does not cure the deficiencies of Iwama and Poretsky with regard to the other limitations (i.e. the limitations pertaining to checking the availability of a telephony network before setting up a call in the data network) of independent claims 37 and 39. Accordingly, claims 37 and 39 are patentable over the combination of Iwama, Poretsky, and Elliott for the same reasons as claims 22 and 43.

The dependent claims listed above are patentable by virtue of their dependency on their respective independent claims. Accordingly, claims 24-27, 30, 32, 34, and 37-42 and 45-46 are patentable over Iwama, in view of Poretsky, and Elliott under 35 U.S.C. § 103.

**Conclusion:**

Applicant submits that this application is in condition for allowance. Accordingly, reconsideration is respectfully requested. Should there remain any unanswered questions the examiner is requested to call the undersigned attorney at the telephone number indicated below. Applicant includes herewith payment of the fee for the Petition for a one-month Extension of Time. Because the period to respond within said one month expired on Saturday, April 2, 2011, no additional extension is believed required. The Commissioner is hereby authorized to deduct any fees believed due, or credit any overpayment to, our Deposit Account No. 50-5470.

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